

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL MULLER and MEGGAN H. TODD

Appeal 2013-000518¹
Application 12/327,870
Technology Center 2100

Before JEAN R. HOMERE, CARL W. WHITEHEAD JR., and
CATHERINE SHIANG, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–16. App. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' Invention

Appellants invented a method and system for managing reciprocal tagging relationships between resources within a computer communications network. Spec. ¶ 7, Fig. 1.

¹ Appellants identify the real party in interest as International Business Machines Corp. App. Br. 2.

Representative Claim

Independent claim 1 representative. It reads as follows:

1. A method for reciprocal tagging of resources in a computer communications network, the method comprising:
specifying a resource in a computing system for tagging and identifying a reciprocal resource to the specified resource;
generating a tag in a social bookmarking system for a specified resource, the tag in the social bookmarking system referencing the reciprocal resource and specifying a relationship between the specified resource and the reciprocal resource;
additionally generating a reciprocal tag in the social bookmarking system for the reciprocal resource, the reciprocal tag referencing the specified resource in the reciprocal tag and indicating a reciprocal relationship between the specified resource and the reciprocal resource; and,
storing both tags in a data store of reciprocal tags for subsequent access in the social bookmarking system.

Prior Art Relied Upon

Brooks	US 2008/0282198 A1	Nov. 13, 2008
Parsons	US 2008/0301237 A1	Dec. 4, 2008

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

Claims 8–16 stand rejected under 35 U.S.C. § 101 as being directed to nonstatutory subject matter.

Claims 1–16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Parsons and Brooks.

ANALYSIS

We consider Appellants' arguments *seriatim* as they are presented in the Appeal Brief, pages 4–16, and the Reply Brief, pages 2–8.²

Dispositive Issue 1: Under 35 U.S.C. § 101, did the Examiner err in concluding that the data processing system recited in claim 8, and the computer program product recited in claim 10 are directed to nonstatutory subject matter?

Regarding the rejection of claim 8, Appellants argue the data processing system recited in the claim is directed to a machine, which is a statutory class of invention. App. Br. 5, Reply Br. 2. In response, the Examiner concludes because the data processing system recited in claim 8 does not necessarily implicate the use of a processor, the claim is directed to software *per se*. Ans. 2. We do not agree with the Examiner. One of ordinary skill would have readily appreciated that the data processing system recited in the claim necessarily implicates the utilization of a processor/hardware (e.g., social bookmarking system) for executing reciprocal tags stored in the data store. Accordingly, we will not sustain the

² Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed May 7, 2012), the Reply Brief (filed October 1, 2012), and the Answer (mailed July 31, 2012) for the respective details. We have considered in this decision only those arguments Appellants actually raised in the Brief. Any other arguments Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

nonstatutory subject matter rejection of claim 8, and claim 9 depending therefrom.

Regarding the rejection of claim 10, Appellants argue because the computer-usable storage medium recited therein is directed to a storage medium storing computer-executable instructions for causing a computer to perform listed operations, it is directed to statutory subject matter consistent with various prior Decisions rendered by the Board. App. Br. 6–9, Reply Br. 2–3. This argument is not persuasive. We note at the outset, because the Board Decisions cited by Appellants are not precedential, they are not binding upon the Board. Rather, *Ex parte Mewherter* is controlling here. In particular, because Appellants' Specification does not define the computer-usable storage medium to exclude transitory media, the claimed medium encompasses transitory media, which is not patent eligible. *See Ex parte Mewherter*, 107 USPQ2d 1857 (PTAB 2013) (precedential). We will therefore sustain the nonstatutory subject matter rejection of claims 10–16.

Dispositive Issue 2: Under 35 U.S.C. § 103, did the Examiner err in finding the combination of Parsons and Brooks teaches or suggests *indicating a reciprocal relationship between a specified resource tag and a reciprocal resource tag*, as recited in claim 1?

Appellants argue the proposed combination of references does not teach or suggest the disputed limitations emphasized above. In particular, Appellants argue while the Examiner has relied upon paragraphs 24, 25, 41, 45, 46, and 51 of Brooks for the disputed limitations, the Examiner has not

explained how the cited textual portions teach or suggest the recited claim language. App. Br. 10–12. Therefore, Appellants submit the Examiner has not met the procedural burden of establishing a *prima facie* case under 35 U.S.C. § 132, and has thereby failed to provide Appellants with the requisite notice. *Id.* at 12–16. Further, Appellants argue while the cited portions of Brooks generally disclose specifying information for creating a set of tags along with associated owners thereof to display in a tag a currently selected resource, they do not teach identifying a reciprocal resource to a specified resource. Reply Br. 6–7. Appellants lament the Examiner’s cutting and pasting of rationales for other elements in the claim does not particularly teach the disputed limitations. *Id.*

In response, the Examiner finds Brooks’ disclosure of a social bookmarking system that provides a tag entry field to allow a user to enter tag information (name, number) in order to generate a tag set subsequently stored in the folksonomy of the bookmarking system teaches specifying resource for tagging. Ans. 3–4. Further, the Examiner finds Brooks’ disclosure of a mechanism for referencing previously generated tags, and for specifying the relationship therebetween teaches or suggests a generated resource tag referencing a reciprocal resource and specifying a relationship between the specified resource and a reciprocal resource. Ans. 4–5. Additionally, the Examiner finds Parsons discloses reciprocal relationships between generated tags. *Id.* at 5.

Upon reviewing the record before us, we find no error in the Examiner’s obviousness rejection of claim 1. We note at the outset, in the

Response to Argument section in the Answer, the Examiner has mapped the previously cited portions of Brooks and Parsons to the disputed claim limitations. Ans. 3–7. In our view, the afore-cited mapping provided in the Examiner’s response is sufficient to establish a prima facie case of obviousness, as well as to provide Appellants with requisite notice of the rejection because one of ordinary skill in the art, having reviewed the cited portions of Parsons and Brooks, would have been able to ascertain the specific findings in support of the obviousness rejection. In particular, we agree with the Examiner Brooks’ disclosure of enabling a user to specify certain design information (e.g., number of tags, names of tags name) to thereby create a set of tags that are stored in the folksonomy of a bookmarking system (¶45) teaches specifying a plurality of tags associated with corresponding resources. Further, we agree with the Examiner Brooks also discloses specifying the relationships between the created tags. ¶¶19, 51. Additionally, we agree with the Examiner that Parsons’s disclosure of determining whether the relationship between two tags within a social network is a reciprocal relationship (¶¶200–202) complements Brooks’ teaching to thereby allow the user to specify the nature of the relationship between created tags. Consequently, we are satisfied on the record before us, the Examiner has established by a preponderance of the evidence that the combination of Brooks and Parsons renders claim 1 unpatentable, thereby shifting to Appellants the burden of showing nonobviousness. However, except for continuously lamenting the alleged insufficiency of the Examiner’s prima facie rejection, Appellants have not made an attempt to

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rebut the afore-cited specific findings made by the Examiner. Accordingly, Appellants' response fails to show the Examiner erred in finding that the combination of Parsons and Brooks teaches the disputed limitations. We will therefore sustain the obviousness rejection of claim 1. Likewise, we will sustain the obviousness rejection of claims 2–16 that are not separately argued. *See* 37 C.F.R. § 41.37(c)(1)(vii).

DECISION

We affirm the nonstatutory subject matter rejection of claims 10–16, as well as the obviousness rejection of claims 1–16 as set forth above. However, we reverse the nonstatutory subject matter rejection of claims 8 and 9.

Because we have affirmed at least one ground of rejection with respect to each claim on appeal, the Examiner's decision is affirmed. *See* 37 C.F.R. § 41.50(a)(1).

AFFIRMED

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